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Paper No. 20

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UNITED STATES PATENT AND TRADEMARK OFFICE

MAY 30 2003

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KI-YOUNG KIM, MIN-SEOP LEE and HWA-KYUNG LEE

Appeal No. 2003-0316
Application 09/179,405

HEARD: MAY 15, 2003

Before JERRY SMITH, RUGGIERO and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-16, 18 and 19, which constitute all the claims remaining in the application.

The disclosed invention pertains to a telephone number searching method and apparatus. More particularly, the invention interconnects a telephone, a web server connected to a telephone

number database, and an information terminal having a web browser. A telephone plug-in is included which automatically dials a telephone number selected by a user which has been provided from the web server to the information terminal.

Representative claim 1 is reproduced as follows:

1. A telephone number searching system comprising:

a phone;

a telephone number database to store multiple predetermined telephone numbers;

a web server connected to said telephone number database;

an information terminal having a web browser, selectively connected to said web server, to submit a search request for searching the predetermined telephone numbers in said telephone number database through said web server, to obtain a telephone number service comprising at least one searched for telephone number among the predetermined telephone numbers in accordance with the search request and to display the at least one searched for telephone number; and

a telephone plug-in, connected with said phone and said information terminal, to automatically dial one telephone number selected by a user among the at least one displayed telephone number to set up a communication channel through said phone independent of said web server and said information terminal.

The examiner relies on the following references:

Shachar et al. (Shachar)	5,764,736	June 09, 1998
Wood et al.	6,091,808	July 18, 2000
		(filed Oct. 17, 1996)

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Claims 1-16, 18 and 19 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Wood in view of Shachar.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-16, 18 and 19. Accordingly, we affirm.

Appellants have nominally indicated that the independent claims do not stand or fall together, but they have not

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specifically argued the limitations of each of these claims. The extent of appellants' arguments, with respect to the independent claims, appears on pages 4-5 of the brief wherein it is stated what is recited in each of the claims and then it is simply asserted that these claims are patentable for the same reasons argued with respect to claim 1 with no additional analysis or discussion of obviousness whatsoever. Simply pointing out what a claim requires with no attempt to separately point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). 37 CFR § 1.192(c)(7) requires that the argument explain "why the claims...are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." Appellants' arguments fail to satisfy this requirement as a basis to have the claims considered separately for patentability. Since appellants are considered to have made no separate arguments for patentability, all claims will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will consider the

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rejection against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellants [see 37 CFR § 1.192(a)].

The examiner has indicated how he finds the invention of claim 1 to be obvious over the collective teachings of Wood and Shachar [answer, pages 3-5]. The examiner finds, inter alia, that the operation of the dial button 75 in combination with the telephone switch 16 in Wood meets the claimed telephone plug-in. Since Wood does not use the term plug-in, however, the examiner also cites Shachar as teaching that it was conventional to use a "plug-in" to set up a communication channel. The examiner finds that it would have been obvious to the artisan to use a plug-in

as taught by Shachar in the information terminal of Wood.

Appellants argue that Wood has no telephone plug-in connected with the information terminal so that there is no plug-in for which another telephone plug-in as taught by Shachar could be substituted. Appellants argue that the examiner's proposed modification is nothing more than an impermissible hindsight reconstruction of the invention [brief, pages 3-4].

The examiner responds that the disclosure of Wood describes a plug-in to the same extent that appellants' disclosure describes a plug-in. The examiner also responds that the operation described in Wood establishes a communication channel through the telephone which is independent of the web server and the information terminal as claimed [answer, pages 6-8].

Appellants respond that although the operation of Wood and the claimed invention achieve similar results, Wood does not disclose a telephone plug-in connected with said phone and said information terminal as claimed. Appellants also assert that there would be no reason to substitute the Shachar plug-in in the Wood device because Wood already achieves the necessary function [reply brief, pages 2-4].

We will sustain the examiner's rejection of all the

claims on appeal. We agree with the examiner that the telephone switch 16 of Wood constitutes a telephone plug-in as claimed. Appellants' specification describes the telephone plug-in as "an apparatus or software for automatically connecting a telephone according to the searched for telephone number" [page 6]. There is no question that the switch in Wood automatically connects the telephone to a number selected from the database on the web facility. The connection in Wood is established between the telephone 10 and the automatically called number "in the same manner as if the number DN [called number] had been dialed by the subscriber at the telephone 10" [column 7, lines 2-5]. Clearly, a number dialed from the telephone 10 in Wood is independent of the switch 16. The web facility is switched out during normal phone calls. Therefore, after the number is provided to the switch 16 by the web facility in Wood, the web facility is switched out and the call is made as if the number had been dialed by the subscriber. Thus, we agree with the examiner that the phone connection which is established in Wood is independent of the web facility and the web browser of Wood in the same manner as in the claimed invention. We also agree with the examiner that the telephone plug-in of Wood is connected to the web browser within the meaning of the claimed invention. Note

that Figure 1 of Wood shows the plug-in 16 connected to information terminal 12 through components 18, 20, 22, 24 and 26. The telephone could also clearly be a part of the web browser such as in a PC modem for searching the internet which would have been clearly understood by the artisan.

Even if the switch 16 of Wood could not be considered to be a plug-in within the meaning of the claimed invention, we would still sustain the examiner's rejection based on the additional teachings of Shachar. We agree with the examiner that Shachar teaches that functions can be added to a conventional telephone by the use of plug-ins. In our view, the artisan would have found it obvious to implement known conventional operations on a telephone by using plug-ins designed to implement the same conventional functions. Therefore, it would have been obvious to the artisan to implement the conventional automatic dialing function taught by Wood using a plug-in designed for that purpose as taught by Shachar.

In summary, we have sustained the examiner's rejection of each of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-16, 18 and 19 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Gerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Joseph F. Buco

JOSEPH F. RUGGIERO
Administrative Patent Judge

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